REMARKS

Applicants have carefully considered the December 19, 2006 Office Action, and the comments that follow are presented in a bona fide effort to address all issues raised in that Action and thereby place this case in condition for allowance. Claims 19-26 are pending. Claims 23-25 have been withdrawn from consideration pursuant to the previous restriction requirement.

In response to the Office Action dated December 19, 2006, no claims have been amended. Entry of the present response is respectfully solicited. It is believed that this response places this case in condition for allowance. Hence, prompt favorable reconsideration of this case is solicited.

Independent claim 19 and dependent claims 21 and 26 were rejected under 35 U.S.C. § 102(a) as unpatentable over Hofschen et al. (WO 99/00962, hereinafter "Hofschen"). Applicants respectfully traverse.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention, such that the identically claimed invention is placed into the possession of one having ordinary skill in the art. *Helifix Ltd. v. Blok-Lok, Ltd.*, 208 F.3d 1339, 54 USPQ2d 1299 (Fed. Cir. 2000); *Electro Medical Systems S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994). Moreover, in imposing the rejection under 35 U.S.C. § 102, the Examiner is required to specifically identify wherein an applied reference is perceived to identically disclose each feature of a claimed invention. *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221

USPQ 481 (Fed. Cir. 1984). That burden has not been discharged. Moreover, there are significant differences between the claimed invention and the device disclosed by Hofschen that would preclude the factual determination that Hofschen identically describes the claimed invention within the meaning of 35 U.S.C. § 102.

In response to Applicants' prior Amendment filed on October 6, 2006, the Examiner asserted that the volume control means controlling both a volume of the replayed music and a volume of a talking voice of the telephone communication is taught by Hofschen. However, Applicants respectfully submit that although Hofschen, at page 7, line 16 through page 10, line 5 (especially page 9, lines 1-12) teaches a feature of reducing or setting to "0" the volume level of the audio (i.e. replayed music") when receiving a call or making a call, the feature of **controlling a volume of a talking voice of the telephone communication** is neither disclosed nor remotely suggested by Hofschen.

Therefore, Hofschen fails to disclose any volume control means controlling a volume of the talking voice of the telephone communication. Therefore, the above argued differences between the claimed subject matter undermines the factual determination that Hofschen discloses the portable telephone set identically corresponding to that recited in independent claim 19. Applicants, therefore, submit that the imposed rejection under 35 U.S.C. § 102 for lack of novelty as evidenced by Hofschen is not factually viable and, hence, solicit withdrawal thereof.

Dependent claims 20 and 22 stand rejected under 35 U.S.C. § 103 as unpatentable over Hofschen in view of in view of Chin (US 5,661,788). Applicants respectfully traverse.

Applicants incorporate herein the arguments previously advanced in traversal of the rejection under 35 U.S.C. § 102(a) predicated upon Hofschen. The secondary reference to Chin does not cure the argued deficiencies of Hofschen. Chin was relied upon by the Examiner for

only disclosing selectively alerting users of preferred telephone calls, but is silent as the claimed volume control means. Thus, even if the applied references are combined as suggested by the Examiner, and Applicants do not agree that the requisite realistic motivation has been established, the claimed invention will not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988). Accordingly, reconsideration and withdrawal of the rejection are respectfully submitted.

It is believed that all pending claims are now in condition for allowance. Applicants therefore respectfully request an early and favorable reconsideration and allowance of this application. If there are any outstanding issues which might be resolved by an interview or an Examiner's amendment, the Examiner is invited to call Applicants' representative at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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